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FEB 22 2005

OFFICE OF PETITIONS

In re Application of
Oettinger, et al.
Application No. 10/763,051
Filed: September 30, 2004
Attorney Docket No. 2003627-0006
For: INTEGRATED X-RAY SOURCE MODULE

ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed January 14, 2005 (certificate of mailing date January 12, 2005), requesting that the application be accorded a filing date of January 22, 2004.

The current petition fee for filing a petition under 37 CFR 1.182 is \$400.00. Petitioner paid only \$130.00. Accordingly, deposit account no. 03-1721 was charged the balance due, or \$270.00.

The petition is **GRANTED** to the extent described below.

The application was filed on January 22, 2004. However, on April 29, 2004, The Office of Initial Patent Examination mailed a "Notice to File Missing Parts of Nonprovisional Application" (Notice) stating, *inter alia*, that the application had been accorded a filing date of January 22, 2004, and advising applicants that figures 5C, 5D, and 5E appeared to have been omitted.

In response, on September 30, 2004 (certificate of mailing date September 28, 2004) petitioners filed, *inter alia*, formal drawings that included Figures 5C, 5D, and 5E.

The Office processed these drawings and accorded the application a filing date of September 30, 2004.

Petitioners request reinstatement of the January 22, 2004 filing date and argue that the omitted drawings submitted on September 30, 2004 should be considered part of the original application papers, because (1) they are not new matter and (2) they were originally filed in prior application No. 10/370,783, the entire disclosure of which was incorporated by reference into the present application at the time of the present application's filing.

The mailing of the Notice permits applicants to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. Applicants asserting that the missing items were in fact deposited in the USPTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. Applicants desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, on September 30, 2004 (certificate of mailing date September 28, 2004) petitioners neither asserted that the missing drawings were actually deposited in the USPTO on January 22, 2004 with the other application papers nor requested a later filing date. They merely filed the figures.

Petitioners wish to retain the January 22, 2004 filing date for the above-identified application. This is possible only if Figures 5C, 5D, and 5E are added to the application **after** the filing date issue has been resolved.

Additional figures may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP § 608.02(a).

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

If applicants desire that figures 5C, 5D, and 5E be added to the application, the appropriate procedure is by way of amendment requesting the entry of the figures. Any such amendment should be filed prior to the first action on the merits and will be considered by the examiner.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of **January 22, 2004**. Drawing figures 5C, 5D, and 5E filed on September 30, 2004 will not be considered part of the original application papers. Only the papers filed on

January 22, 2004 constitute the original application papers.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.

A handwritten signature in black ink, reading "E. Shirene Willis". The signature is written in a cursive, flowing style.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy